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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,099	01/16/2002	Keizaburo Matsumoto	020043	5715

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ARMSTRONG, KRATZ, QUINTOS, HANSON & BROOKS, LLP
1725 K STREET, NW
SUITE 1000
WASHINGTON, DC 20006

EXAMINER

DICUS, TAMRA

ART UNIT PAPER NUMBER

1774

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/030,099	Applicant(s) MATSUMOTO, KEIZABURO	
	Examiner Tamra L. Dicus	Art Unit 1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 10 and 12 is/are rejected.
- 7) ☒ Claim(s) 7-8, 11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The 112 rejection is withdrawn due to Applicant's arguments.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6, 10, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,829,790 to Phillips in view of USPN 6,214,449 to Otani et al.

3. Phillips teaches a greeting card (printed matter) comprising a paper sheet 12 of an ink jet printed with a color ink jet printer (col. 1, line 45-46) (variable information is formed). See col. 2, line 29. The greeting card can be preprinted lithographically with any desired theme (col. 3, lines 15-20) (print film containing fixed information printed). Further, that a print film is printed by various printing methods (lithographic, intaglio, relief of instant claim 1 and ink jet printing of instant claim 9) is a process limitation in a product claim and afforded little patentable weight. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product

Art Unit: 1774

was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698. Thus, Applicant’s article and the prior art article is the same.

4. Phillips does not teach one or two receiving layers comprising an ink-absorbing and ink-fixing resin as per instant claims 1-5 nor the additional ink over the receiving layer(s) as claim 10 recites. Phillips as cited above, already teaches lithographic ink print on paper (claim 10).

Otani teaches coating (claims 10 and 12) two ink receiving layers (col. 3, lines 25-28) containing cellulose, polyvinyl alcohol (col. 4, lines 14-25) (ink-absorbing additive) and cationic dye fixing agents (col. 4, lines 27-31). Further additives include fillers of UV absorbents, pigments, and fluorescent dyes (col. 4, lines 33-37). Otani teaches water based ink jet ink is recorded on the paper having ink receiving layers to form an image thereon (col. 1, lines 1-10).

It would have been obvious to one of ordinary skill in the art to modify the greeting card of Phillips to further include one or two receiving layers comprising cellulose, fillers, and ink-fixing agents because Otani teaches the inclusion of said layers provides ink absorbency, high image density, high surface strength and reduction in cost can be attained (col. 3, lines 24-29). The inclusion of aforesaid ink-absorbing, ink-fixing, and fillers are conventionally added to effect the image density (col. 4, lines 15-68 of Otani). Ink is on the paper having ink-receiving layers to form an image. Thus, the combination results in the same instant invention.

Further to claims 10 and 12, Phillips and Otani do not teach the methods of an in-line system or anilox rollers for forming the layers. However, the processes of forming the layers are process limitation in a product claim and afforded little patentable weight.

Art Unit: 1774

Claims 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,829,700 to Phillips in view of USPN 6,214,449 to Otani et al., and further in view of USPN 6,708,612 to Schmid.

Phillips and Otani, relied upon above, do not teach the use of an in-line system or anilox rollers as per instant claims 10 and 12. Schmid teaches a printing machine for printing sheets receiving ink using an in-line operation, ink jet printers, and anilox rollers (col. 2, lines 35-40, 60-65, and col. 4, lines 23-25). Schmid discovered this machine allows two inks to be printed from two different printing machines at the same time (col. 4, lines 50-55). It would have been obvious to one of ordinary skill in the art to modify the combination of Phillips and Otani because Schmid teaches the use of ink jet printers and anilox rollers in an in-line system for the purpose of printing paper successively with different colors (col. 3, lines 55-56 and col. 4, lines 51-55 of Schmid).

Claims 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,829,700 to Phillips in view of USPN 6,214,449 to Otani et al., and further in view of USPN 6,830,329 to Iwata.

Phillips and Otani, relied upon above, do not teach the use of an in-line system or anilox and rubber rollers as per instant claims 10 and 12.

Iwata teaches an image was formed on the obtained recording medium by means of an ink-jet printer thereafter, the ink-receiving layer processed through a steel and rubber roll in order to bond an ink-receiving layer to produce a finished printed article. While Iwata does not explicitly teach an "anilox" roll, the steel roll is functionally equivalent to an anilox roll, as both are capable of processing ink and ink-receiving layers.

It would have been obvious to one of ordinary skill in the art to have modified the combination to form ink-receiving layers via two rolls, namely anilox and rubber, because Iwata teaches it is known to produce ink-receiving layers through such rolls in order to bond an ink-receiving layer to produce a finished printed article (col. 3, lines 1-21 and col. 8, lines 34-35).

Allowable Subject Matter

5. Claims 7-8 and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The applied prior art does not teach a receiving layer comprising a layer adjoining the printing ink film of the oil-based ink and containing different ingredients, wherein the layer adjoining the printing ink film of the oil-based ink contains a film-forming acrylic resin obtained by emulsion polymerizing monomers containing 15% by weight or more of a methacrylic ester compound containing an alkyl group having 8 to 18 carbon atoms as recited in instant claims 7 and 11, wherein instant claim 11 is directed to a method for producing printed matter according to claim 7, or printed matter as instant claim 6 recites having a coating agent further containing 1 to 8% by weight of at least one film forming-improving agent selected from the group recited in claim 8.

Response to Arguments

Applicant's arguments filed 08-25-05 have been fully considered but they are not persuasive.

Art Unit: 1774

Applicant alleges the instant invention is in the order: paper/fixed information/receiving layer/variable information and that lithographic fixed information is on top of paper or side by side with or underneath a receiving layer. The Examiner understands the structure as recited in claims 1 and 10. There is no claim to fixed information extending laterally across the entire paper surface so that the receiving layer does not contact paper, nor which surface (e.g. top or bottom or edge) any print is on paper or receiving layer(s). In fact, fixed information via lithographic printing is a discontinuous layer, not a continuous layer, as Applicant infers and further Applicant has not excluded any layer from contact with a paper surface.

Applicant contends that there is no suggestion for fixed information under ink-receiving layers and is inconsistent with the order as in instant claim 10. However, because Phillips teaches “pre-printing” on paper with lithographic print, printing is indeed on paper and in combination with Otani teaching ink receiving layers on paper to receive ink. It is indeed obvious to supply ink receiving layer(s) to arrive at the instant invention as ink receiving layers assist in absorbing the ink. See Phillips col. 1, lines 45-46, col. 2, lines 15-17 and lines 50-60, and col. 3, lines 2-5 teaching a variety of fixed and variable printed ink via hand, computers and printers such as ink jet types, and lithographically. Further to the methods of printing, again, the instant claims are to a product, not process, and so long as the end product is provided, the process is given little weight. How the receiver layer(s) or ink is formed are process limitations. The same order is taught in combination.

Applicant argues Philips involves many choices of paper including ink jet paper and simple selection of a paper would not lead to the specific combination. The Applicant claims paper and Philips teaches paper throughout the patent, as Applicant noted “paper” sheet 12 at

Art Unit: 1774

col. 2, lines 16-17. Applicant has not excluded ink jet paper or specified what type of paper is employed.

All other arguments are moot in view of the Examiner's answers indicated above. Again, the card of Philips contains preprinted lithographic printing and additionally prints on the pre-printed card with ink jet ink (col. 1, lines 45-47 and col. 2, lines 50-56) to personalize the card. Otani teaches ink-receiving layers are on paper to attract ink and thus improves ink absorption, which provides suggestion for the combination. Schmid is still used to address one method option, using the in-line system. Iwata is still used to show it is known to form said layers using the same and functionally equivalent anilox and rubber rolls. Thus the combination would result in the claimed invention, structural and materially.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

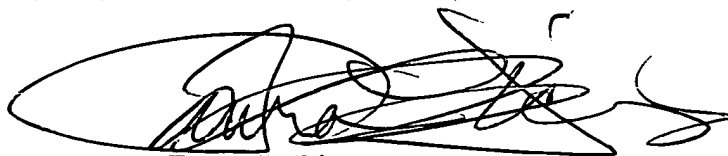
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit: 1774

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tamra L. Dicus
Examiner
Art Unit 1774

October 20, 2005



RENA DYE
SUPERVISORY PATENT EXAMINER

A.U. - 1774 10/31/05